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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,626	10/11/2001	Robert E. Haines	10007582-1	1665

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EXAMINER	
BLAIR, DOUGLAS B	

ART UNIT	PAPER NUMBER
2442	

MAIL DATE	DELIVERY MODE
06/09/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/976,626

Applicant(s)

HAINES ET AL.

Examiner

DOUGLAS B. BLAIR

Art Unit

2442

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,10-16,18,19,27-32 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) 27-32,35 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,10-16,18 and 19 is/are rejected.
- 7) ☒ Claim(s) 36 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

The applicant was presented with a restriction requirement via telephone. Claims 1, 5-8, 8-16, 18, 19, 36, and 37 are drawn to process 2 described in the applicant's specification. Claims 27-32, 35, and 38 are drawn to process 1 described in the applicant's specification. The two separate processes are claimed as subcombinations usable together.

The applicant elected without traverse of claims 1, 5-8, 8-16, 18, 19, 36, and 37 in a telephonic interview on 6/1/2010 with Todd Rathe (Reg. No. 38,276).

Claims 27-32, 35, and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the interview on 6/1/2010.

Response to Arguments

As to section I of the applicant's Remarks, the deletion of the incorporation by reference is acknowledged and entered.

As to section II, the 35 USC section 112 rejection is withdrawn.

As to section III, the claims rejected under 35 USC section 101 are cancelled so the arguments are moot. The applicant's arguments would not be persuasive because if a claim is broad enough that it could cover non-statutory subject matter then it clearly covers non-statutory subject matter and is therefore not patentable under 35 USC section 101.

As to the arguments against the prior art, these arguments are moot in view of the revised rejections.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 13, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant cancelled the reference to PML from the specification. PML was the only thing close to an XML script disclosed by the applicant.

Claims 5, 13, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant's specification does not provide any description of what an XML script comprises. Specifically, XML is a markup language and not a scripting language. XML is a language for representing data but does not by itself provide any support for scripting. Therefore the meets and bounds of the applicant's "XML script" cannot be determined based on the claims and the disclosure supporting the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8, 10, 11, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Number 2001/003827 by Shimamura in view of U.S. Patent Number 7,126,716 to Kaufman et al.

Shimamura teaches a method of configuring a hard copy output engine comprising: receiving an electronic message including hard copy output engine configuration data from an undesignated website (Fig. 1, ref. number 102) through a firewall (Fig. 1, ref. numbers 104 and 301), wherein the electronic message transmitted through the firewall designates a hardcopy output engine to be configured (Fig. 9); and configuring the hard copy output engine using the hard copy output engine configuration data (Figure 3, the command executer performs the configuration); wherein receiving the electronic message comprises receiving an email at the hard copy output engine; however Shimamura does not explicitly teach configuration via an embedded web server.

Kaufman teaches the concept of using an embedded web server in a printer to configure the printer (col. 5, line 61-col. 6, line 8).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Shimamura regarding using email to configure a printer with the teachings of Kaufman regarding an embedded web server because an embedded web server would be an alternate means to the email transmitter/receiver disclosed by Shimamura and would not require any substantial modifications of Shimamura in order to be viable. Furthermore it's noted that the applicant's specification does not feature any details about how the web server is implemented and therefore does not put the public into possession of any novel information in exchange for patent protection.

As to claim 6, see paragraph 3 of Shimamura.

As to claims 8-11 and 14-16, they are rejected for the same reasoning as claims 1 and 6.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7, 12, and 19 they are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Number 2001/003827 by Shimamura in view of U.S. Patent Number 7,126,716 to Kaufman et al in view of U.S. Patent Number 6,310,692 to Fan et al and U.S. Patent Application Publication Number 2008/0313007 by Callahan et al.

As to claims 7, 12, and 19, the Shimamura-Kaufman combination teaches the subject matter of the independent claims however the Shimamura-Kaufman combination does not explicitly teach the specifically claimed thresholds and parameters claimed by the applicant.

Fan teaches user defined thresholds for reordering printer materials (Fig 4 and col. 4, lines 15-29). Callahan teaches monitoring the time a device is operated (paragraph 23) and keeping track of model number, name, and serial number parameters (paragraph 29) in the context of printer configuration.

It would have been obvious to one of ordinary skill in the Networking art at the time of the invention to combine the teachings of the Shimamura-Kaufman combination regarding printer configuration with the teachings of Fan and Callahan because the teachings of Fan and Callahan provide specific types of parameters that could be applied to the broader teachings of the Shimamura-Kaufman combination.

Allowable Subject Matter

Claims 36 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claims 36 and 37 are drawn to the concept described by process 1 of the applicant's specification. The combination of the applicant's process 1 and process 2 was not found to be anticipated or made obvious by any of the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Lee can be reached on (571) 272-3967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/
Primary Examiner, Art Unit 2442